

“Wherein *conj* 1. In which; where; 2. During which; 3. How; in what respect. (Black’s Law Dictionary, *Bryan A. Garner* – Editor in Chief, 2nd Pocket Edition; 3rd reprint-2003, pg. 765)

The term “wherein” in claims 12-22 has been appropriately amended to more clearly reflect the proper meaning and definition of the respective claim such that the limitations of the claims are clearly defined.

In response to Examiner’s objection to the specification for failing to provide proper antecedent basis for the claimed subject matter of claims 12-22. See 37 C.F.R. 1.75(d)(1) and MPEP § 608.01(o). The originally filed specification recited “model mapping”. There is no mention of either a “model mapping” in the specification (November 14, 2008).[sic] Appropriate action is required.

“In regards to rejected claims 12-22 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Examiner is unclear as to what is Applicant’s claimed “model mapping”. Applicant requests Examiner to review the specification of application 09/896,238 in order to obtain an understanding of model mapping, in particular topographical mapping as it pertains to the present application.

Applicant would like to draw the Examiner’s attention to the *original* specification filed 6/21/2001, (pg7, lines 35-38) where the specification recites:

“Modeling of Results

The relevant results are modeled for display. This may require information to be ordered, tabulated, or otherwise formatted for each type of visual or audio display specified by the user. *Topographical mapping is a method of modeling* and is described below.”

Therefore the specification *does* provide for antecedent basis, however for providing clarity the claims have been amended to more clearly state topographical mapping.

The Examiner had requested a copy of the specification of the Aurigin's PCT application WO98/55945. Applicant provided a copy of the Aurigin's PCT application WO98/55945 in the response as requested. Applicant was *not* requested to, and therefore *did not* submit, a specification of application 09/896,238 on November 14, 2008, which is the present application under examination and may be found in PAIR by the examiner without delay.

Examiner is unclear as to what is meant by the following claimed limitations:

- (1) "minimally a plurality of patents" (Claim 20, (1)) for example and "a meaningful manner."
- (2) "optionally simultaneous" (Claims 14-15)
- (3) "simultaneous and optionally" (Claim 15)
- (4) "simpler combination" (Claim 15)
- (5) "near instantaneous" (Claim 17)
- (6) "instantaneous" (Claim 13)
- (7) "meaningful manner" (Claim 20)
- (8) "minimally problem solving solutions and optionally" (Claim 21)
- (9) "minimally valuation solutions" (Claim 22)
- (10) "causing" (Claims 20-22) What is meant by "causing"?

In response to the Examiner being unclear what is meant by the proceeding claimed limitations:

- (1) Claim 20 has been duly amended to remove the word "minimally".
- (2) Claims 14 & 15 have been duly amended to remove the word "optionally".
- (3) Claim 15 has been duly amended to remove the word "optionally".
- (4) Claim 15 has been duly amended to remove the word "simpler".
- (5) Claim 17 has been duly amended to remove the phrase "and instantaneous or near instantaneous".
- (6) Claim 13 has been duly amended to remove the word "instantaneous".
- (7) Claim 20 has been duly amended to remove the phrase "meaningful manner".
- (8) Claim 21 has been duly amended to remove the words "minimally" and "optionally".
- (9) Claim 22 has been duly amended to remove the word "minimally".

(10) Claims 20-22 have been duly amended to remove the word “causing”

All claims should be reviewed. Further clarification and explanation is required. Examiner does not understand what Applicant intends these limitations to mean, thereby rendering the Application difficult to further examine.”

Applicant is at a loss to understand how after 8 years of prosecution, two first rejections followed by a withdrawn Notice of Allowance which is not in the record, an RCE and two final rejections all with the same Examiner, the Examiner now states that the Examiner does not understand the claims and finds the application at this late date difficult to examine.

Claims 20-22 are rejected under 35 U.S.C. § 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office’s guidance to Examiners that a 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing.

Thus, claims 20-22 are non-statutory and rejected under 35 U.S.C. § 101 since they may be performed in the human mind.

Claims 20-22 claim the review of data (1) causing **generation of an electronic patent shoe**; (2) causing access to a **user interface device to distribute**, by means of an **audio or visual or audiovisual display**. Electronic patent shoes, user interface devices, audio or visual or audiovisual displays are all particular apparatus of a different class and may not be performed in the human mind. As well, the data is transformed from alphanumeric lists and tables to display via **audio or visual or audiovisual display** into a **topographical map** providing specific desired information that becomes available and can be displayed for the user.

With regard to claims 12 and 19 being rejected under 35 USC 101 because the claimed invention is directed to non-statutory subject matter. Claim 12 (and its dependent claim 19) recite a “system” comprising a “*server...client and computer program*” for storing, retrieving and searching. The Examiner notes the disclosure of the present invention expressly states “*the*

server executes SIPS-VSM to run its intelligent agent.” See Specification page 7 which states that *“computer executes the intelligent search engine.”* The Examiner’s own interpretation is that all functions described herein may be performed in either hardware or software. Thus, for the purposes of examination, the Examiner interprets the recited “determining unit and the recited “system” to comprise only computer software. Accordingly, the “system” recited in claims 12 and 19 are in fact software systems and this fact is clear throughout the specification.

Computer software is not a process, a machine, a manufacture or a composition of matter. Accordingly, claims 12 and 19 fail to recite statutory subject matter, as defined in 35 USC 101.

Claim 12, which has been previously presented, clearly describes a process which can be implemented by using a computer. The functionality and utility of the invention and the results of using the invention are clearly described as follows: the system allows for searching, retrieving, and storing into and from one or more databases information regarding intellectual property within a technology exchange, a problem solving database, and a science and engineering database, **resulting in topographical mapping and valuing said intellectual property according to one or more search criteria specified by a user.**

With regard to claims 12, 19 and 20 being rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette, et. al., US Patent No. 6,499,026-B1 (Rivette hereinafter) and in view of Kevin W. Boyack, et. al. (Paper entitled, “Analysis of Patent Databases Using VxInsight”, March 29, 2001, published by Sandia National Laboratories and referred to as Boyack hereinafter).

Rivette describes a method of displaying data, comprising the steps of: (1) accessing patent-related documents; (2) accessing one or more groups each comprising any number of patent-related documents; (3) automatically generating a hyperbolic tree containing data from any of the patent-related documents; and (4) allowing a user to selectively focus on at least some of the data that is displayed in a portion of the hyperbolic tree.

With regard to claims 12, 19 and 20 being rejected under 35 USC 103(a) as being unpatentable over Rivette, et. al. (U.S. Pat. No. 6,499,026) herein referred to as Rivette in view of Kevin W.

Boyack, et. al. (Paper entitled. "Analysis of patent Databases Using VxInsight", March 29, 2001, Published by Sandia National Laboratories and referred to Boyack hereinafter). Neither Rivette nor Boyack individually nor in combination describe the simultaneous or instantaneous retrieving, analyzing, topographical mapping and valuing of IP in a technology space prior to the filing date of this application on 6/29/2001. In fact, Boyack's description of the software developed at Sandia, VxInsight, is identical in function and design in almost all aspects to the invention described by Rivette. Neither the patent by Rivette nor the paper by Boyack include adding **valuation** to the topographical mapping portion of the present disclosure, which forms a key essential feature of the present application.

Valuation of patents and patent portfolios adds leverage to a user's knowledge and understanding regarding the overall health or condition of a business, either when purchasing, selling, merging or investing in their own business or that of another business. Neither the systems of Rivette nor Boyack add the valuation features of the present application. In summary, neither Rivette nor Boyack, nor the combination of Rivette and Boyack disclose, anticipate, teach, or motivate one to provide the valuation system described and detailed in the present application.

Claims listing:

Claims 1-11 (Canceled)

Claims 12-22 (Currently amended)